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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,278	01/31/2002	Larry E. Mashburn	T2317-907720	5374
181 7590 01/10/2007 MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT 1771	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/059,278

Applicant(s)

MASHBURN ET AL.

Examiner

Cheryl Juska

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-14 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 and 23-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission of Remarks and a Declaration under 37 CFR 1.131 filed on October 31, 2006, has been entered.

### ***Response to Arguments***

2. Applicant has not filed an amendment with the RCE, but rather relies upon the 131 Declaration filed on October 31, 2006, to traverse the prior art rejection. Applicant asserts this newly filed 131 Declaration overcomes the deficiencies of the Kurth Declaration filed November 22, 2005, as noted in the Advisory Action of April 13, 2006 (Remarks, pages 2-3). The examiner respectfully disagrees.

3. While said new Declaration is properly label with the current application serial number (i.e., 10/059,278) and is executed by the proper individuals (i.e., the named inventors of the present application), said Declaration is insufficient to overcome the rejection based upon the Kurth reference (US 2002/0090488) for at least the following reasons:

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- a. Section 3 of the Declaration discusses application 09/974,301 having Kurth as a named inventor. However, the applied reference (US 2002/0090488) of the present rejection is based upon application 09/974,302 rather than the '301 application.
  - b. While the new Declaration does not improperly cite claim numbers of the Kurth application, said Declaration does incorporate the deficiencies of the Kurth Declaration filed November 22, 2005, in section 7 and in Exhibit A of said Declaration.
  - c. The scope of the declaration is not commensurate in scope with the presently claimed invention. Note MPEP 715.02.
  - d. No documentary evidence of the facts have been submitted with said declaration. Note MPEP 715.07, I, III.
  - e. The date to swear behind is the effective filing date of the Kurth reference 220/0090488, which is October 10, 2000, not 2001 as recited in section 6 of said Declaration.
4. For this reason, said Declaration is insufficient to overcome the prior art rejections of record. As such, the rejections set forth below are repeated from the Final Rejection of September 9, 2004.
5. Additionally, it is noted that applicant's response filed with the RCE does state the double patenting rejections will be addressed upon indication of allowable subject matter. However, until then, said double patenting rejections are maintained.

### ***Priority***

6. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-35 of this application. Specifically, provisional application 60/275,631 does not provide support for the independent claim limitation that the multi-functional alcohol is "present in a ratio to said vegetable oil such that there are at least 0.7 moles of OH groups per mole of bulk vegetable oil." Additionally, there are numerous dependent claim limitations that are not supported (e.g., specific compositional components and the amounts thereof). Thus, applicant's claim for domestic priority under 119(e) is not granted and the effective filing date of claims 1-35 is January 31, 2002.

### ***Double Patenting***

7. Claim 12 stands objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4, as set forth in section 2 of the last Office Action. Applicant traverses on the grounds that the two claims employ different transitional phrases. However, it is argued that the transitional phrase of "is" recited in claim 4 is considered open language equivalent to the transitional phrase "comprising" recited in claim 12. If applicant intends to recite closed language in claim 4, it is suggested the claim be amended to recited "consists of."

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Dependent claims 13-25 and 30-35 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-26 and 28-33, respectively, of copending Application No. 10/097439. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to select the claimed multifunctional alcohol as the cross-linking agent and to add a catalyst since said cross-linking alcohols and catalysts are readily known in the art of polyurethanes.

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This is a provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102/103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-16, 18, 19, 22, 26-29, and 32 stand rejected under 35 USC 102(e) as being anticipated by, or in the alternative under 35 USC 103(a) as being unpatentable over US 2002/0090488 issued to Kurth et al. as set forth in section 11 of the last Office Action.

***Claim Rejections - 35 USC § 103***

12. Claim 17 stands rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference.

13. Claims 20, 21, 24, 25, 30, 31, 34, and 35 stand rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference in view of US 6,060,145 issued to Smith et al.

14. Claims 23 and 33 stand rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference in view of US 2003/0114062 issued to Scott et al.

***Conclusion***

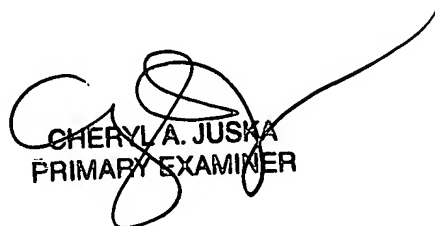
15. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER